

**REMARKS**

**INTERVIEW SUMMARY**

This paper responds to the Forms PTOL-85 and PTOL-413 dated May 18, 2010.

Please find attached Summary of the Substance of the Interview.

**DATE OF INTERVIEW:** May 14, 2010

**PARTICIPANTS:** Examiner Tae H. Yoon (Group 1796)

Sandra P. Thompson, PhD (Reg. No. 46,264)

**TYPE OF INTERVIEW:** Telephonic

**EXHIBITS:** None

**CLAIMS DISCUSSED:** All

**PRIOR ART DISCUSSED:** Of Record

**AGREEMENT WITH RESPECT TO THE CLAIMS WAS NOT REACHED.**

**PROPOSED AMENDMENTS & RESOLUTION:**

The Examiner and Dr. Thompson discussed the issue of the "solvent system" as recited in claim 18 and the description of the "solvent system" in the Detailed Description. Dr. Thompson agreed to review the claims and refine the claim language to clarify the solvent system in the claims.

**35 USC 112**

Claims 18, 20, 22, 24, 25, 36, 42, 51-52 and 54 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant respectfully disagrees based on the amendments included herein.

The "comprising" language has been amended in each of the rejected claims except for claim 54. Claim 54 does not refer to the content of the solvent system, but in fact refers to the method of evaporating the solvent system. The Applicants respectfully request that the Examiner withdraw the rejection with respect to claim 54 on this basis and with respect to the other remaining claims based on the amendments presented herein.

**35 USC §§ 102 AND 103**

Claims 18-20, 24-27, 30-36, 42, 47-49, 51-56 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Kobayashi (US 5965319).

Claims 18-22, 24-27, 30-36, 41-42, 47-49, 51-56 and 76-77 are rejected under 35 USC 103(a) as obvious over Kobayashi (US 5965319) in view of Hattori (US 6165676).

Claims 18-22, 24-25, 36, 41-42, 47-49, 51-52 and 76-77 are rejected under 35 USC 103(a) as obvious over FR 281602 in view of Hattori (US 6165676) and further in view of Miyamoto et al (US 6808857).

Claims 18-21, 24-25, 36, 41-42, 47-49, 51-52 and 76-77 are rejected under 35 USC 103(a) as obvious over FR 281602 in view of Drage (US 5858547) and further in view of Miyamoto et al (US 6808857).

The Applicant respectfully disagrees with all of these rejections.

The independent claims include the phrase "consisting of". MPEP Section 2111.03 states:

"The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.")"

Claim 18 recites: " A planarization composition, consisting of: an o-cresol-based polymer compound and a resol phenolic resin; at least one surfactant; and a solvent system consisting of at least one solvent."

Claim 36 contains similar provisions as the ones in Claim 18.

The Examiner lists the Kobayashi reference as the primary reference; however, the citation of this reference against the novelty or nonobviousness of this application is mooted by virtue of the amendments presented herein. The Examiner admits as much when referring to his interpretation of the instant "solvent system" on page 3 of the current office action. The phrase "solvent system" is amended in the claims, and therefore, the Examiner's argument is moot with respect to this primary reference.

The other primary reference in these rejections is the FR 2801602. These components in FR 2801602 consist of catalysts based on sulfonic acid. The Examiner appears to be missing the point of the reference and at the same time applying it incorrectly to the current case. Regardless of which components are added to the resol-based resin or the catalyst in FR 2801602, there is no question that the final product is a combination of the resol-based resin and the catalyst based on sulfonic acid. There is absolutely nothing in FR 2801602 that indicates that one of these components could be utilized separately before combination with the other. The entire reference is designed to describe the invention of combining resol-based resins and catalysts. So, there is absolutely no motivation or suggestion to one of ordinary skill in the art based on this reference to pull ½ of the product out and use it for something other than "consolidation of unstable ground for public road construction, mining, etc". The Examiner's comment that if one took all of the components of FR without a catalyst would be prima facie obviousness is nonsensical, because FR doesn't state, motivate one or suggest that one would not use the catalyst in any instance. This would be analogous to citing a motorcycle patent against a bicycle and saying "the motorcycle without the motor/engine would be prima facie obviousness". A motorcycle contains a motor, and there is nothing anywhere that suggests that it could be used without the motor and with manual peddling

to form a bicycle.

The Hattori, Miyamoto and Drage references do not cure the obvious deficiencies of Kobayashi and/or FR 2801602, and therefore, claims 18 or 36 are allowable in this application. The remaining dependent claims are also allowable by virtue of their dependence on allowable claims 18 or 36.

**CONCLUSION**

The undersigned Attorney-of-Record respectfully requests an interview to resolve any remaining issues the Examiner has after review of this response, in order to avoid additional and lengthy written prosecution. Dr. Thompson is available during the week from 8AM to 4PM PST and can be reached at 949-224-6282. A request for an Interview is attached for the Examiner's immediate reference. It should only be considered if this application is not in immediate condition for allowance.

**REQUEST FOR ALLOWANCE**

Claims 18-22, 24-27, 30-36, 41-42, 47-49 and 51-56 and 77-78 are pending in this application, and the Applicant respectfully requests that the Examiner reconsider the claims in light of the arguments presented and allow all pending claims.

Respectfully submitted,  
Buchalter Nemer, A Professional Corp.



Dated: August 18, 2010

By:

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